



UNITED STATES PATENT AND TRADEMARK OFFICE

M

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,045	12/18/2000	Jacques Bauer	GEI-084	6820
20311	7590	07/27/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016			RUSSEL, JEFFREY E	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	09/720,045	BAUER ET AL.
Examiner	Art Unit	
Jeffrey E. Russel	1654	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 5 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 5-8.

Claim(s) rejected: 4 and 16-31.

Claim(s) withdrawn from consideration: _____.

8. The drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. Other: _____.

Art Unit: 1654

1. The proposed amendment to the claims filed July 14, 2004 will not be entered because the amendment format used in certain of the claims is not permitted under 37 CFR 1.121. In particular, it appears as though single bracketing was used to show deletions from, e.g., claim 21, lines 6, 7, and 11-15, and claim 23, lines 5 and 6. Further, at claim 27, line 1, "of" was inserted after "product" without underlining, and at claim 27, line 2, "a" was changed to "an" after "reacted with" without strikethrough and underlining.
2. The sequence listing statement filed July 14, 2004 is identical to the one filed February 5, 2004, and therefore does not address the issues set forth in section 2 of the final Office action.
3. The proposed new Brief Description of the Drawings still lacks a Brief Description of Figure 47, and thus the objection set forth in section 3 of the final Office action is not overcome. Also, the proposed addition to the Brief Description of Figures 10 and 12 indicating that they are based upon supernatants of human dendritic cells culture, and the proposed addition to the Brief Description of Figures 13-20 indicating that the mice have been immunized with a malaria antigen, raise the issue of new matter. The examiner has been unable to find support in the figures themselves or in the detailed descriptions of the figures for these new descriptions.
4. With respect to section 4 of the final Office action, there was no response to the rejection of claim 21 based upon two conflicting definitions of the variable "n" at lines 7 and 8.
5. With respect to section 5 of the final Office action, there was no response to the objection to claim 17, line 1, concerning "compositions", and there was no response to the objection to claim 23, line 4, concerning the comma after "atoms".
6. In addition to those objections and rejections which would have remained from the final Office action, Applicants' proposed amendments to the claims filed July 14, 2004 raise the

following new issues: At proposed claim 16, line 7, “substituents” should be changed to “substituent”. At proposed claim 21, lines 11-15 appear to duplicate lines 16-24. At proposed claim 21, line 16, the beginning bracket does not match the end parenthesis. At proposed claim 21, line 19, “dihydroxyphosphoryloxy” should be changed back to “dihydroxyphosphonyloxy”. At proposed claim 21, lines 20, “dimethoxyphosphoryl” should be changed back to “dimethoxyphosphonyl”. There is no support for the new substituent listed at proposed claim 21, line 23. The limitation “in need of an immune response” at proposed claim 31, line 4, raises new issues requiring further consideration and/or search, it being much narrower in scope than the previous limitation “in need of immune modulation”. Proposed claim 31 raises new issues under 35 U.S.C. 112, second paragraph, because it no longer recites any positive process steps. Note that there is no verb such as “administering” in the claim. Proposed claim 32 raises issues under 35 U.S.C. 112, second paragraph, because it purports to be drawn to a method of obtaining a compound of formula I according to claim 21, but formula I in claim 32 is defined differently than formula I in claim 21. In formula I in claim 32, the NHR₁ and the NHR₂ groups in the formula are misplaced. At proposed claim 32, “dihydroxyphosphoryloxy” should be changed back to “dihydroxyphosphonyloxy” and “dimethoxyphosphoryl” should be changed back to “dimethoxyphosphonyl”. There is no support for the new substituent listed at proposed claim 32, page 11, line 1. Proposed claim 32 is indefinite because there is no “q+1” position in the diamino acid. In proposed claim 32, page 13, lines 1 and 8-9 should be omitted as being redundant. Proposed claim 33 raises the same new issues as does proposed claim 32. At proposed claim 33, page 15, line 4, “integer” is misspelled.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (703) 872-9306; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.



Jeffrey E. Russel

Primary Patent Examiner

Art Unit 1654

JRussel

July 23, 2004